



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,504	07/10/2006	Gerd Breiter	DE920020043US1	8083
46429 7590 08/04/2011 CANTOR COLBURN LLP-IBM POUGHKEEPSIE 20 Church Street 22nd Floor Hartford, CT 06103				
EXAMINER ANDERSON, FOLASHADE				
ART UNIT 3623		PAPER NUMBER		
NOTIFICATION DATE 08/04/2011		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/562,504
Filing Date: July 10, 2006
Appellant(s): BREITER ET AL.

Nelson S. DaCunha (63,592)
For Appellant

EXAMINER'S ANSWER

This is in response to the supplemental appeal brief filed 06/30/2011 appealing from the Office action mailed 11/26/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-15 are pending and stand rejected.

Claims 16-20 are canceled.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

2002/0107761	Kark et al.	08-2002
2002/0059090	Yanagimachi	05/2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 and 8 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example amended claim 1 now recites the limitation of "said provider offering being distinct from a resource catalog, wherein said provider offering is input into a transformation component," the Examiner is unable to discern any portion of the specification that provides support for the "said provider offering being distinct from a resource catalog."

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kark et al. (US Publication 2002/0107761 A1) in view of Yanagimachi (US Publication 2002/0059090 A1).

5. Claims 1, 8, and 15

Kark teaches a method for automatically transforming a provider offering describing a customer specific service environment in business terms into a form which

is automatically executable by a resource management system, the method comprises the steps of:

- receiving a description of a provider offering in business terms without any references to specific resources (Abstract "Information from a plurality of manufacturer catalog are provided" and par. 0075) said provider offering being distinct from a resource catalog, wherein said provider offering is input into a transformation component (par. 0041 "product information may be updated less frequently or may be updated in a more manual process to permit the catalog owner to select particular products or to re-define categories or other attributes associated with the products selected from the higher layer catalog" and par. 0052 "the present invention enable filtering of presentation of a catalog information based upon factors such as the particular portal used to enter the catalog or based upon other criteria of the viewer of the catalog" where the filter is interpreted to be the equivalent of the transformation component.);
- providing access to the resource catalog containing descriptions of all available resource types including information about dependencies of said resource types belonging to said customer specific service environment as well as reference information to execute resource management actions for said resource types (par. 0052 "enable filtering of presentation of a catalog information based upon factors such as the particular portal used to enter the catalog or based on other criteria of the viewer of the catalog")

- wherein said resource catalog is input into the transformation component (par. 0052 and 0121 “database to filter out particular products from the catalog based upon external parameters” where catalog information is run through the filtering component);
- mapping said description of said provider offering with said resource type information contained in said resource catalog and generating a customer specific service environment topology tree comprising the steps of (Abstract “resellers having established relationships . . . extract information . . . from higher layer catalog to generate their own catalog” and par. 0097 “link tables is used to define marketing linkages and ties among products”):
 - using said provider offering by the transformation component as a root node of a customer specific service environment topology tree to be generated (par. 0075 “customer catalogs may be created for particular markets or customers by extracting information from a corresponding channel partner” and par. 0121) wherein said provider offering is distinct from said resource catalog (par. 0041);
 - adding identified resource types as nodes in said topology tree which are mapping with said provider offering (par. 0097 “MAPFROM and MAPTO fields identify specific fields that can associate the product with related products” where the fields are the equivalent to nodes);

- adding child nodes to said identified nodes when said identified resource types which are aggregated resource types map into a set of lower level resource types which are child resources (par. 0047, 0056 and fig. 7)
 - repeating the previous steps until said resource types cannot be mapped into set of lower resource types which are base resource types (par. 0103 "entries to be added to the catalog and processing continue looping back to element 600" and par. 0104 " and fig. 6);
- traversing said customer specific service environment topology tree, wherein each node in said customer specific service environment topology tree represents a resource types (par. 0097 "MAPFROM and MAPTO fields identify specific fields that can associate the product with related products" where the fields are the equivalent to nodes);
- compiling said sequenced management actions into a machine readable form executable by said resource management system (Abstract "Information from a plurality of manufacturing catalogs are provided and integrated" and par. 0113 "the process may also be performed automatically using timed event processing and script controls" It is note that while Kark does not show the particulars of the types of catalogs only disclosing in the general terms of manufacture/producers the claimed act of compiling is the same as the integration/aggregation step of Kark).

Kark teaches gathering and extracting information from a plurality of manufactures (see abstract and par. 0075-0076) which implies that resource management action catalogs are encompassed in this process; however does not expressly teach the claimed step of providing information is done to a resource management action catalog containing resource management actions each describing how to manage a single resource type by a resource control system; extracting from said resource management action catalog all resource management actions of said resource types identified in said customer specific service environment resource topology tree or sequencing said extracted resource management actions according to requirements of said defined customer specific service environment; and environment.

Yanagimachi teaches in the analogous art of job state administration:

- providing access to a resource management action catalog containing resource management actions each describing how to manage a single resource type by a resource control system (par. 0927 "transfers the job data regarding the job of "New spring catalog" together with information on the set action" and par. 0937 "the working state table and action state table, the variable amount of accounting is extracted")
- extracting from said resource management action catalog all resource management actions of said resource types identified in said customer specific service environment resource topology tree (par. 0927 "transfers the job data regarding the job of "New spring catalog" together with

information on the set action" and par. 0937 "the working state table and action state table, the variable amount of accounting is extracted")

- sequencing said extracted resource management actions according to requirements of said defined customer specific service environment; and environment, (par. 0023 "direct connection is defined as an action or state of logical connection wherein the job directory of a working object is the destination for connection", and figs. 43-44 with accompany text).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Kark the features as taught by Yanagimachi since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 8 is substantially similar to claim 1 and is therefore rejected for the same reasoning given above. Kark teaches the additional limitation of claim 8:

- a transformation component for generating a customer specific service environment topology tree by (Abstract "system for multi-layered channel marking catalog generation"):
- a compilation component for generating a customer specific service environment definition by :

Claim 15 is substantially similar to claim 1 and is therefore rejected for the same reasoning given above.

6. Claim 2

Kark and Yanagimachi teach the method according to claim 1, and Kark further teaches wherein said resource management actions includes the operations creation, management and deletion of said resource types (par. 0042-0046 and 0102).

7. Claim 3

Kark and Yanagimachi teach the method according to claim 1, and Yanagimachi further teaches wherein said sequence is defined by input and out parameter of said resource management actions (par. 0018 and 0829).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Kark the sequence is defined by input and out parameter of said resource management actions as taught by Yanagimachi since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

8. Claim 4

Kark and Yanagimachi teach the method according to claim 1, and Yanagimachi further teaches wherein said sequence is implemented as workflow executable by said resource management system (par. 0745-0752; where process flow is the equivalent of workflow).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Kark the sequence is implemented as

workflow executable by said resource management system as taught by Yanagimachi since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

9. Claim 5

Kark and Yanagimachi teach the method according to claim 1, and Yanagimachi further teaches wherein said resource management actions are used to define decision logic in form of rules to control the execution of said resource management actions (par. 0311, 0319 and 0334).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Kark the resource management actions are used to define a decision logic in form of rules to control the execution of said resource management actions as taught by Yanagimachi since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

10. Claim 6

Kark and Yanagimachi teach the method according to claim 5, and Kark further teaches wherein said defined work flow process or said decision logic is implemented in a form of XML data (Abstract and par. 0038).

11. Claim 7

Kark and Yanagimachi teach the method according to 1, and Kark further teaches wherein said reference information includes a URL pointing to a Web Service with the corresponding Web Service description for execution of said resource management actions (par. 0002, 0038).

12. Claim 9

Kark and Yanagimachi teach the system according to claim 8, and Kark further teaches wherein said resource catalog contains categorized aggregated resource types which contain references to one or more other resources types with other parameters for them or a certain combination of them or both (par. 0092 and 0097).

13. Claim 10

Kark and Yanagimachi teach the system according to claim 8, and Kark further teaches wherein said provider offering forms the highest aggregation level of aggregated resource types and the base resources form the lowest not further expandable level in said resource catalog, wherein only said base resource types contain reference information to execute resource management actions for said resource types (fig. 5 and accompanying text).

14. Claim 11

Kark and Yanagimachi teach the system according to claim 8, and Kark further teaches wherein said resource catalog may be implemented in a form of a table stored in a database, or XML file stored in a file system (Abstract and par. 0038).

15. Claim 12

Kark and Yanagimachi teach the system according to claim 8, and Kark further teaches wherein said resource management actions includes creation, management, and deletion of said resource types (par. 0042-0046 and 0102).

16. Claim 13

Kark and Yanagimachi teach the system according to claim 8, and Yanagimachi further teaches wherein each resource management action is defined by the name of the resource type, its task and its specific input and output parameter (par. 0018 and 0829).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Kark the resource management action is defined by the name of the resource type, its task and its specific input and output parameter as taught by Yanagimachi since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

17. Claim 14

Kark and Yanagimachi teach the system according to claim 8, and Yanagimachi further teaches wherein the result of said compilation component is a machine-readable description of sequenced resource management actions as well as decision logic for operating said customer specific service environment (par. 0023, 0489, & 0893).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Kark the result of said compilation

component (125) is a machine-readable description of sequenced resource management actions as well as decision logic for operating said customer specific service environment as taught by Yanagimachi since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

(10) Response to Argument

Applicant makes the following arguments:

1. With respect to the 35 U.S.C. 112, 1st paragraph rejection of claims 1 and 8 Applicant argues "[p]age 11, lines 9-21 of the Specification as published recites inter alia "The offering describes the service environment exclusively in business terms without any references to specific resources." In addition, FIG. 1 clearly shows the provider offering (reference 110) and the resource catalog (reference 112) as distinct inputs to the transformation component (reference 115.) ("The provider offering 110 and information from the Resource Catalog 112 are used as input for the Transformation component 115." Page 7, lines 14-27, emphasis added.) Furthermore, the functional descriptions of the provider offering and the resource catalog are different. Whereas the provider offering describes a "customer specific service environment... exclusively in business terms without any references to specific resources" (page 11, lines 9-21), the resource catalog "contains categorized aggregated resource types, which provide

several abstraction levels within the resource catalog." (Page 8, lines 18-23, emphasis added)." See Appeal pages 13-14.

Respectfully the Examiner disagrees with Applicant's assertions. The instant specification is the void of the term "distinct." It is noted that the purpose of the specification is to convey a "description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same." The language of the claims does not have to mirror that of the specification however the meaning of the claim language must be "clear, concise, and exact terms." The instant specification provides no guidance on the meaning of the claimed "distant" within the context of the application. In other words the specification does not provide one of ordinary skill in the art with the means for distinguishing what is "distinct" from what is not.

The cited portion of the specification would not allow one of ordinary skill in the art to determine what is bounded by the claimed term "distinct." Applicant is essentially requesting that meaning be given to the limitation for which the specification is silent. The rejection is maintained.

2. With respect to the 35 U.S.C. 103 rejection of claims 1, 8, and 15 Applicant argues " Kark discloses that each of the catalogs is made up of product information selected directly from the parent catalogs, and therefore does not teach or suggest "said provider offering being distinct from a resource catalog."" See Appeal pages 15, 19, and 22 respectively.

Even if it is assumed that the specification provides support for the limitation of "said provider offering being distinct from a resource catalog," Kark disclosure would have rendered the limitation obvious to one of ordinary skill in the art at the time the invention was made.

Kark teaches as Applicant points out a parent-child relationship within the catalog system/method. Kark specifically states in par. 0041 "product information may be updated less frequently or may be updated in a more manual process to permit the catalog owner to select particular products or to re-define categories or other attributes associated with the products selected from the higher layer catalog" and par. 0052 "the present invention enable filtering of presentation of a catalog information based upon factors such as the particular portal used to enter the catalog or based upon other criteria of the viewer of the catalog . . . allows the definition of particular products to be excluded from view by a user of the catalog." Finally Kark teaches "methods . . . for generating and maintain product catalogs . . . having a plurality of manufactures . . . and selectively copying portions of the industry master catalogs to a plurality of channel partners catalogs, each representing goods . . . available from the a corresponding channel partner." (par. 0056)

In other words the child catalog created in Kark takes applicable parts/services information from various manufactures/industry catalogs to present to the end user. Each end user's catalog view is unique or distinct based on their filtering settings. Thus one of ordinary skill in the art would have recognized the claimed limitation as obvious in light of the teachings of Kark.

3. With respect to the 35 U.S.C. 103 rejection of claims 1, 8, and 15 Applicant argues "Kark discloses the ability to filter what parts of a catalog are presented to users based on a number of factors, however the filtering of Kark does not teach or suggest "providing access to the resource catalog containing descriptions of all available resource types including information about dependencies of said resource types... as well as reference information to execute resource management actions for said resource types."" See Appeal pages 16, 20 and 23 respectively.

Kark teaches in par. 0052 "enable filtering of presentation of catalog information based upon factors such as the particular portal used to enter the catalog or based on other criteria of the viewer of the catalog. . . "stoplist" data structure allows the definition of particular products to be excluded from view by a user of the catalog based on such criteria of the user." Finally Kark teaches "a flowchart of a method of the present invention that applies the STOPLIST tables of the database to filter out particular products from the catalog . . . a typical application of such stop list processing may be to suppress particular products from particular manufacturers when a user accesses the catalog . . . Element 1001 then locates all products (items) associated with the stop list loaded for this particular use of the catalog . . . Those skilled in the art will readily recognize that the access of both child and parent catalogs by a single process presumes access to both catalogs from a single process." (par. 0121)

Kark makes know that it was well known in the art at the time the invention was made that numerous programming filtering means could be used to view a catalog by the end user. It would have been obvious to one of ordinary skill in the art that these

filters could be as restrictive or as open as need to meet the requirements of the end user.

With respect to the claimed "information about dependencies of said resource types, ..., as well as reference information to execute resource management actions for said resource types" Kark teaches the "remaining fields are used to track revisions of pricing and other data relating to products. Revision information is used to selectively update data in a catalog from its parent catalog . . . price and product data revision fields are also referred to herein as price revision index and product data revision index, respectively." (par. 0088). Kark also teaches "a check for the parent" catalog looking for the items in the manufacturer level that are parents of the items in the industry level. The check pulls all items with a revision number greater than this product's current revision number," (par. 0044).

The teaching of Kark discloses the method/system takes the action to perform a verification of the revisions of the part/service prior to presenting the information to the end user. Kark also filing information on the revisions; therefore, the claimed limitation would have been obvious to one of ordinary skill in the art at the time the invention was made.

4. With respect to the 35 U.S.C. 103 rejection of claims 1, 8, and 15 Applicant argues "[t]he combination of Kark and Yanagimachi, however, is devoid of teaching or suggesting "using said provider offering by the transformation component as a root node of a customer specific service environment topology, tree." See Appeal pages 16, 20, and 24 respectively.

Kark teaches par. 0075 "customer catalogs may be created for particular markets or customers by extracting information from a corresponding channel partner" and par. 0121. Where the channel partner catalog is interpreted to be the root node and the particular market catalogs derived are interpreted to be the claimed "customer specific service environment topology, tree." Also see Kark figure 4.

5. With respect to the 35 U.S.C. 103 rejection of claims 1, 8, and 15 Applicant argues "the combination of Kark and Yanagimachi is devoid of teaching or suggesting "adding identified resource types as nodes in said topology tree which are mapping with said provider offering."" See Appeal pages 16, 21, and 24 respectively.

Kark teaches "LINK table 506 is used to define marketing linkages and ties among products. For example, it may be useful in a marketing catalog to link an electronic toy in the catalog with batteries because users of the catalog who purchase such a toy are likely to purchase the required batteries. . . MAPFROM and MAPTO fields identify specific fields that can associate the product with related products" (par. 0097). Where linking is interpreted to mean the same as mapping. Kark connects products that would be used together so as to offer them.

Alternatively if the Examiner has misunderstood the limitation Kark also teaches "RODUCT table 504. As above, the NAME field provides an owner defined name for the product defined by each record. The PRODUCTID is a unique value used as a key for the table and the CATALOGID links each record to the particular catalog in which it is included. The LINKFROM field in this table indicates another product, if any, from

which this record represents a sub-product or sub-component" (par. 0085). Thus in other words product offered are link at sub-product resource levels.

Therefore the teachings of Kark would have rendered the claimed limitations obvious to one of ordinary skill in the art at the time the invention was made.

6. With respect to the 35 U.S.C. 103 rejection of claims 1, 8, and 15 Applicant argues "Kark is devoid of teaching or suggesting "adding child nodes to said identified nodes when said identified resource types, which are aggregated resource types, map into a set of lower level resource types which are child resources." See Appeal pages 17, 21, and 25 respectively.

Kark teaches "method includes the steps of: providing an industry master catalog having an aggregation of a plurality of manufacturer catalogs including information regarding products or services available from a corresponding manufacturer; and selectively copying portions of the industry master catalog to a plurality of channel partner catalogs, each representing goods or services of a manufacturer available from a corresponding channel partner," (par. 0056) and "RODUCT table 504. As above, the NAME field provides an owner defined name for the product defined by each record. The PRODUCTID is a unique value used as a key for the table and the CATALOGID links each record to the particular catalog in which it is included. The LINKFROM field in this table indicates another product, if any, from which this record represents a sub-product or sub-component" (par. 0085).

Therefore the teachings of Kark would have rendered the claimed limitations obvious to one of ordinary skill in the art at the time the invention was made.

7. With respect to the 35 U.S.C. 103 rejection of claims 1, 8, and 15 Applicant argues "Kark is devoid of teaching or suggesting "compiling said sequenced management actions into a machine readable form executable by said resource management system." See Appeal pages 18, 22, and 25 respectively.

Kark teaches in the Abstract "Information from a plurality of manufacturing catalogs are provided and integrated" and par. 0113 "the process may also be performed automatically using timed event processing and script controls," where scripting is an old and well known synonym for computer executable programming. The scripting of Kark inherently is contained on a computer readable medium. Therefore the teachings of Kark would have rendered the claimed limitations obvious to one of ordinary skill in the art at the time the invention was made

8. With respect to the 35 U.S.C. 103 rejection of claim 7 Applicant argues "Kark nor Yanagimachi, either alone or in combination, teach or suggest "a Web Service with the corresponding Web Service description for execution of said resource management actions." See Appeal page 18.

Kark teaches invention relates to electronic commerce and in particular relates to methods and systems for improved channel sales support in a vendors Internet-based electronic commerce," (par. 0002); "a "portal" is an Internet site designed to attract users based upon particular content available through that site" (par. 0019); and "Manufacturer catalog information is preferably fed to the master catalog of the present invention in industry-standard XML formats. The Open Catalog Format (OCF) standard

is exemplary of one such standard XML format that may be used in association with the present invention." (par. 0038)

By its very definition an internet portal is equivalent of the claimed limitation. In addition to the description provided by Kark it is old and very well known in the art that a portal is a website (web service) that presents information from diverse sources in a unified manner (the execution of the system). Further it is also old and very well known in the art the XML is an encoding method used to execute commands via a web server. Therefore the teachings of Kark would have rendered the claimed limitations obvious to one of ordinary skill in the art at the time the invention was made.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Folashade Anderson/

Examiner, Art Unit 3623

/BETH V BOSWELL/

Supervisory Patent Examiner, Art Unit 3623

Art Unit: 3623

Conferees:

Beth Boswell /bvb/

Supervisory Primary Examiner, Art Unit 3623

Vincent Millin /vm/

Appeals Practice Specialist